

Application No. 10/661,281  
Reply to Office Action of February 9, 2006

Docket No.: 14173-00001-US

### REMARKS

Applicants request reconsideration of the application as amended.

Claims 1, 12, and 23 have been amended to include the limitation that the friction reducing means is coaxially positioned between the spinner and the hub or axle. Claims 2 and 13 have been amended to include the limitation that the retaining means is coaxially positioned around the hub or axle. Claims 3 and 14 have been amended to include the limitation that the spacer is coaxially positioned between the spinner and the hub or axle. Claims 4 and 15 have been amended to include the limitation that the first side wheel hub includes a first side wheel hub central bore, said first side wheel hub central bore configured to be coaxially positioned around said wheel axle shaft, said first side wheel hub in physical communication with at least one of said spacer, said friction reducing means, and said retaining means. These amendments are supported *inter alia* by paragraphs 53 and 57 of the originally filed application.

Claims 18 through 22 are amended to correct typographical errors.

Claims 24 and 25 are newly presented. These claims are supported *inter alia* by paragraphs 16, 23, and 29 of the originally filed application.

### 35 U.S.C. § 103 Rejection of Claims 1-4, 7, 9-15, 18, and 20-23

The Examiner has rejected claims 1-4, 7, 9-15, 18, and 20-23 under 35 U.S.C. § 103(a) as being unpatentable over Fitzgerald (U.S. Patent No. 6,776,459) in view of Murnin (U.S. Patent No. 1,500,884). More particularly, the Examiner states that Fitzgerald discloses some of the stated limitations in the claims, but admits that Fitzgerald fails to teach the claimed spinner assembly, which comprises a spinner attachment system in which one of an axle and a hub are insertable through the spinner. To cure the deficiency of Fitzgerald, the Examiner states that the general concept of providing a spinner through which an axle and hub is insertable therethrough

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is well known in the art as illustrated by the Murnin reference. Applicant respectfully traverses this rejection.

The test for obviousness of a claimed invention relative to the prior art is whether the subject matter claimed as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the relevant art. 35 USC § 103(a). As a matter of law, four factual inquiries must be made regarding: 1) the scope and content of the prior art; 2) the level of ordinary skill in the art; 3) the differences between the claimed invention and the prior art; and 4) secondary considerations such as commercial success, long felt but unresolved need, failure of others, copying and unexpected results. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

During patent examination the Examiner bears the burden of presenting a prima facie case of obviousness. *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002). If the Examiner fails to meet this burden, applicant is entitled to the patent. *Id.* Only when a prima facie case is made does the burden shift, requiring applicant to come forward and rebut the showing of obviousness with patentability evidence and/or arguments. *Id.* Patentability is then determined on the record as a whole, by a preponderance of evidence and weight of arguments. *Id.*

A prima facie case of obviousness requires that all claim limitations be taught or suggested by the prior art. Manual Patent Examination Procedure, 2143.03 (8th Ed., Rev. 3, Aug. 2005) (citing multiple cases) In establishing a prima facie case of obviousness, the Examiner must show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine [or otherwise modify] the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Namely, there must be particular findings related to the obviousness determination. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). Broad conclusory statements standing alone are

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insufficient. *Id.* The factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). Commonly, a new invention consists of a combination of old elements. *In re Kotzab*, 217 F.3d at 1369. Thus, every element of a claimed invention is often found in the prior art. *Id.* However, merely pointing out each separate claim element in the prior art is insufficient to defeat patentability of the claimed invention. *Id.* A prima facie case of obviousness can either be disproved or rebutted. Showing that the art in any material respect teaches away from the claimed invention disproves the existence of a prima facie case. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1350 (Fed. Cir. 2000), cert. denied, 530 U.S. 1238 (2000). A prima facie case may be rebutted through a showing of secondary considerations. *Id.* See also *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990).

Fitzgerald teaches an air-driven rotating device that is engaged with a mounting cup attached to the end of an axle. The air-driven rotating device is attached to the mounting cup by the use of a screw, which holds together a cone end cap to the cup to retain the rotating device therebetween. The rotating device interacts with the screw through a bearing that is not coaxially positioned between the rotating device and at least one of the hub or the axle. Thus, the rotating device taught by Fitzgerald does not include a central bore through which a wheel axle shaft or wheel hub is insertable or a friction reducing means coaxially positioned between the rotating device and at least one of the hub or the axle as required by the claims.

Applicants also respectfully submit that the Examiner has improperly equated Fitzgerald's mounting cup with the Applicants' hub or axle. The present claims require a spinner including a spinner central bore through which at least one of a wheel axle shaft and a first side wheel hub is insertable during mounting to the wheel. In Fitzgerald, a screw--and not an axle, a

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hub, or even a mounting cup--is inserted through the spinner central bore. Thus, the Fitzgerald's spinner assembly cannot be equated to the presently claimed invention. Moreover, there is no suggestion in Fitzgerald that the mounting cup or cap is inserted through the central bore of the rotating device, as would be necessary for Fitzgerald's mounting cup and cap to be comparable to Applicants' hub and axle.

The spinner taught by Murnin, similar to the spinner taught by Fitzgerald, is attached to the end of a hub or wheel. More particularly, the spinner is attached to a collar that engages with a cap, which is attached to the hub of a wheel. However, Murnin fails to teach or suggest the claimed limitation that a friction reducing means is coaxially positioned between the spinner and the hub or axle. Instead, Murnin, like Fitzgerald, teaches a device that is attached to the end of an axle. This is unlike the presently claimed invention in which the friction reducing means is coaxially positioned between the spinner and the hub or axle. Thus, according to the present invention, there is no need for an extension piece, such as a cap or cup, to attach the spinner because the spinner is coaxially positioned around the hub or axle.

Because Murnin and Fitzgerald do not teach or suggest, alone or in combination, the wheel spinner assembly as claimed by Applicants in independent claims 1, 12, and 23, withdrawal of the rejection and allowance of the independent claims and their dependents is respectfully requested.

**35 U.S.C. § 103 Rejection of Claims 8 and 19**

The Examiner rejected claims 8 and 19 as being unpatentable over Fitzgerald and Murnin as applied to claims 1 and 12 and further view of Fenton (U.S. Patent No. 3,338,084). The Examiner admits that Fitzgerald fails to teach the concept of a wheel spinner assembly comprising radially disposed pockets responsive to the friction of passing air for increasing

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angular momentum. The Examiner then cites Fenton as illustrating that concept. Applicants traverse the rejection.

Fenton teaches an ornamental apparatus that does not rotate independently of the wheel. Specifically, in column 2, lines 69-71, Fenton describes how lugs in the wheel prevent rotation of the axle cap. The portion that Fenton calls a "spinner" is screwed to the axle cap using threaded screws and, therefore, Fenton's "spinner" does not rotate independently of the wheel. Thus, Fenton fails to cure the deficiencies of Fitzgerald and Murnin because none of the references teach or suggest, either alone or in combination, a wheel spinner comprising radially disposed pockets responsive to the friction of passing air for increasing angular momentum of inertia of the spinner as required by claims 8 and 19.

Because Murnin, Fitzgerald, and Fenton do not teach or suggest, alone or in combination, the wheel spinner assembly as claimed by the Applicants in claims 8, and 19, withdrawal of the rejection and allowance of the claims is respectfully requested.

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**Conclusion**

In view of the above amendment and remarks, Applicants respectfully request that the Examiner withdraw the rejections under §103 and declare the application to be in condition for allowance.

Enclosed is a Petition for a three-month extension of time, along with a fee transmittal. Applicants also submit a Request for Continued Examination (RCE). If any additional fee is due, please charge our Deposit Account No. 03-2775, under Order No. 14173-00001-US from which the undersigned is authorized to draw.

Respectfully submitted,

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